

REMARKS


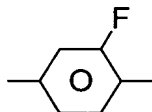
The Rejections under 35 U.S.C. §101 and §112

The rejections under 35 U.S.C. § 101 and 35 U.S.C. §112, second paragraph, are believed to be rendered moot by the cancellation of claim 10 and the amendment to claim 7.

The Rejection under 35 U.S.C. §102 over JP 10-251186

The rejection of claims 1-9 and 11 under 35 U.S.C. §102, as being anticipated by JP 10-251186 is respectfully traversed.

It is believed that compounds #289-387 and #442-478 of the JP reference are excluded by the proviso added to claim 1 above. Thus, JP '186 discloses no liquid crystalline medium which contains a compound according to applicants' formula IA not excluded by the proviso. For example, a review of the long list of compounds provided in JP '186 shows that there are no compounds disclosed which fall within applicants' formula IA wherein Liquid-crystalline medium according to Claim 1, which comprises at least one compound of the

formula IA wherein  is , Z¹ is a single bond and Z² is -CF₂O-. In the absence of any specific disclosure of a composition, or even of a compound, which meets all elements of the instant claims, there is no anticipation and the rejection under 35 U.S.C. §102 should be withdrawn.

It is further urged that JP '186 fails to support a rejection of the claims under 35 U.S.C. §103. JP '186 provides a very broad generically encompassing formula (1). However, it provides an exhaustive list of over 600 specific compounds which set out the true

disclosure of the reference. Applicants respectfully submit that, in view of this disclosure, one of ordinary skill in the art would not be fairly directed to compounds other than those specifically listed. In view of In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), and In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994), it is pointed out that the law does not support that "... regardless of how broad, a disclosure of a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. In view of the extreme breadth of the JP '186 generic disclosure and the failure of any direction to media containing compounds meeting applicants' formula IA with proviso, there is no fair suggestion of applicants' claimed invention to one of ordinary skill in the art under 35 U.S.C. §103.

The Rejections under 35 U.S.C. §102 and §103 over Heckmeier

The rejections of claims 1-9 and 11 under 35 U.S.C. §102 or §103, as being anticipated or obvious over Heckmeier (U.S. Patent No. 6,827,990) are respectfully traversed.

The 102(e) effective prior art date of Heckmeier is May 27, 2003. Applicants have claimed a priority date from German application no. 10245849.9 of September 30, 2002. A certified copy of the priority document has been filed and, as noted in the Office Action, was received by the PTO. Applicants submit herewith a verified translation of the priority document for the purpose of perfecting the claim to priority. Upon such perfection, Heckmeier would be removed from the prior art, in which case the art rejections based thereon should be withdrawn.

Regarding the 35 U.S.C. §103 rejection, it is further pointed out in accordance with 35 U.S.C. §103(c) that the subject matter of the reference and the claimed invention were, at

the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Thus, Heckmeier is not available as prior art under 35 U.S.C. §103.

The Obviousness-type Double Patenting Rejections

The rejections or provisional rejections for obviousness-type double patenting over each of U.S. Patent Nos. 6,827,990 and 6,890,607 and US Application Nos. 10/885,729, 10/885,672 and 10/885,731, are overcome by the attached terminal disclaimer directed to each of these patents/applications.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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